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**AFTER FINAL RESPONSE
EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP ART UNIT 3732**

PATENT

Customer No. 22,852

Attorney Docket No. 05725.0945-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Vincent DE LAFORCADE) Group Art Unit: 3732
)
Application No.: 09/902,092) Examiner: R. Doan
)
Filed: July 11, 2001)
)
For: FOAM CORE COSMETIC CASE) **Mail Stop AF**
)

Commissioner for Patents
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Sir:

REQUEST FOR RECONSIDERATION

In response to the final Office Action of August 11, 2003, Applicant respectfully requests that the Examiner reconsider the present application and withdraw the claim rejections for the reasons explained in detail below.

As an initial matter, Applicant would like to thank Examiner Doan for the courtesy and consideration extended to Applicant's representatives during the personal interview conducted on August 7, 2003. During the interview, the following issues were discussed.

In the final Office Action, claims 1 and 3 were rejected under 35 U.S.C. § 103(a) based on Montiel (U.S. Patent No. 4,446,965) in view of Spector (U.S. Patent

No. 4,884,704). Applicant respectfully traverses that rejection because the final Office Action fails to establish a *prima facie* case of obviousness.

In order to establish a *prima facie* case of obviousness, among other requirements, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one having ordinary skill in the art, to modify the reference or to combine reference teachings." M.P.E.P. § 2142. In other words, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." Id. at § 2143.01 (citation omitted). Furthermore, even if there is a legally proper suggestion or motivation to combine the references in the hypothetical manner proposed, "the prior art . . . references . . . must teach or suggest all the claim limitations." Id. at § 2142 (emphasis added).

As will be explained in more detail below, the final Office Action fails to establish that Applicant's independent claim 1 is *prima facie* obvious for at least two reasons. First, there is no suggestion or motivation to modify the Montiel reference in view of the Spector reference in the hypothetical manner proposed in the rejection statement. Second, even if the proposed hypothetical modification were made to the Montiel reference, that modification still would not result in disclosure or suggestion of all the subject matter recited in Applicant's independent claim 1. Accordingly, Applicant's independent claim 1 is not *prima facie* obvious, and therefore, the final Office Action's rejection under 35 U.S.C. § 103(a) based on Montiel in view of Spector is improper and should be withdrawn.

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The final Office Action's rejection statement of claim 1 acknowledges that the Montiel reference does not disclose "a covering material covering at least a portion of the foam core and defining an exterior surface of the cosmetic product, wherein the covering material comprises a material other than foam." Final Office Action at 2-3. The final Office Action asserts, however, that the Spector reference discloses "a cosmetic container (fig. 2) comprising a container (10) having a fabric covering material (11)." Id. at 3. The final Office Action thereafter concludes that it would have been obvious to "employ the covering material as taught by Spector into the cosmetic container of Montiel for the purpose of providing aesthetic look." Id. Notwithstanding that unsupported conclusion, there is no suggestion or motivation in either the Montiel reference or the Spector reference to modify the device of Montiel in the hypothetical manner proposed in the final Office Action.

The Montiel reference discloses a spill-proof applicator 10 for finger nail treatment liquids, such as nail polish removers, nail and cuticle conditioners, and priming coats. The spill-proof applicator 10 includes a container 12 and a tightly fitting screw cap cover 15. A synthetic plastic foam sponge 16 saturated with a liquid for treating finger nails 18 is dimensioned to substantially fill the container 12 and to be held "unslippingly" within the container 12 so that the if the container 12 is inverted, the sponge 16 will not be dislodged and none of the liquid 18 will be spilled. The sponge 16 includes centrally disposed cross-slits 20 to facilitate insertion of a finger tip F to be treated and to ensure good contact between the finger nail N and a surface of the sponge 16. In use, each finger tip F in turn is inserted into the cross-slits 20, held for a few seconds, then rotated slightly.

The Spector reference, on the other hand, discloses a perfume container formed by a plain glass bottle 10 encased in a low-cost ornamental fabric 11, which transforms the appearance of the bottle 10 and renders it highly attractive and costly looking to impart a greater value to the perfume contents. The bottle 10 includes a flat upper shoulder 13 joined to a cylindrical neck 14, which is threaded to receive a cap 15. Before the bottle 10 is inserted into the fabric casing 11, the surface of the bottle is coated with a bonding agent so that the fabric of the fabric casing 11 is integrated with the bottle 10. The fabric casing 11 includes a lip 11A formed by an internal channel 11B through which a drawstring 16 extends. When the bottle 10 is within the fabric casing 11, the upper section 11A of the fabric casing is caused to overlie the flat upper shoulder 13 of the bottle 10, and the ends of the drawstring 16 are tied around the neck 14 of the bottle 10.

The sole purpose disclosed in the Spector reference for encasing the perfume bottle 10 in the fabric casing 11 is "to provide a container for perfume which makes use of a plain bottle . . . whose appearance is transformed by an ornamental, low-cost fabric casing whereby the container appears to be expensive and thus imparts a similar impression to the perfume contents." Col. 2, lines 29-34. This stated purpose is reinforced by the Spector reference's rather lengthy discussion about why consumer's purchase more expensive perfume. See col. 1, line 20, through col. 2, line 13 (explaining that perfume manufacturers place an unusually high importance on packaging appearance because perfume purchasers associate high quality package appearance with high quality perfume). In fact, the Spector reference distinguishes other purposes for providing bottles encased in fabric by explaining that "it is to be noted

that in the wine field some bottles are encased in monk's or other rough cloth, not to render the bottle more attractive but to protect it against breakage." Col. 2, lines 22-25. Therefore, the Spector reference apparently limits its disclosure to transforming plain perfume containers into a form that appears expensive so that consumers might think they contain expensive perfume.

By virtue of the Spector reference's very limited disclosure relating to encasing perfume containers in a fabric casing, there is no suggestion or motivation for modifying the Montiel reference in the hypothetical manner proposed in the rejection statement. Since the Montiel reference discloses a spill-proof container for containing nail treatment liquids which are marketed in a manner completely different from expensive perfume products, there would have been no suggestion or motivation to transform the Montiel container into an expensive looking container so that consumers might think it contains an expensive product. Furthermore, since the Montiel reference discloses a container for applying a finger nail product including finger nail polish remover, any hypothetical fabric casing would more likely become stained, bleached, or otherwise unattractively soiled by repeated use according to the methods disclosed in the Montiel reference. In addition, such a fabric casing would increase manufacturing and packaging costs. Accordingly, a person skilled in the art of containers for containing finger nail application products would not look to Spector's teachings relating to decorated perfume bottles. Therefore, neither Montiel nor Spector provides any legally proper suggestion or motivation to modify the Montiel finger nail product container in the hypothetical manner proposed in the final Office Action's rejection statement.

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Even if for the sake of argument the proposed hypothetical modification were made to the Montiel device based on the Spector disclosure, that modification would not disclose or suggest all of the subject matter recited in Applicant's independent claim 1.

Applicant's independent claim 1 recites a cosmetic product including, among other things, "at least one recess formed in [a] foam core, the at least one recess for surrounding and containing a cosmetic product" The combination of the Montiel and Spector references fails to disclose or suggest at least that recited subject matter.

The final Office Action's rejection statement asserts that the Montiel reference discloses "a container (12) having a foam core (16), at least one recess (20) forming [sic] in the foam core which contains a cosmetic composition (col. 1, lines 45-46)" Final Office Action at 2. Applicant respectfully disagrees with that assertion. The Montiel reference discloses that a "[s]ynthetic plastic foam sponge 16, saturated with treating liquid 18 . . . is provided with centrally disposed cross-slits 20 to facilitate insertion of a finger tip F" Col. 1, lines 51-52 and lines 58-59. The "cross-slits 20" are not "at least one recess for surrounding and containing a cosmetic composition" at least because the Montiel cross-slits 20 do not "surround" the treating liquid 18, which saturates the sponge 16. In fact, it is more accurate to say that the treating liquid 18 surrounds the cross-slits 20. Furthermore, the Montiel cross-slits 20 do not "contain" the treating liquid 18 at least by virtue of the fact that the foam sponge 16 is "saturated" with the treating liquid 18. For at least those reasons, the final Office Action's hypothetical proposed combination of the Montiel and Spector references fails to disclose or suggest all of the subject matter recited in Applicant's independent claim 1.

Accordingly, the final Office Action fails to establish a *prima facie* case of obviousness with respect to Applicant's independent claim 1 based on the Montiel and Spector references at least because there is no legally proper suggestion or motivation to combine those references in the hypothetical manner proposed, and because, even if they could be combined, not all of the subject matter recited in Applicant's independent claim 1 would be disclosed or suggested by that hypothetical combination. Therefore, Applicant's independent claim 1 should be allowable.

In the final Office Action claims 1, 2, 4, 5, 7-12, and 14-25 were rejected under 35 U.S.C. § 103(a) based on Skarne in combination with Spector. Claims 1, 4, and 16 are the only independent claims rejected based on Skarne combined with Spector, and Applicant respectfully traverses that rejection because there is no legally proper suggestion or motivation to combine the Skarne and Spector references in the hypothetical manner proposed in the final Office Action.

As outlined above, in order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or to combine reference teachings. M.P.E.P. § 2142. If, however, "the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Id. at § 2143.01 (citation omitted). Because the final Office Action's hypothetical proposed modification to the Skarne device would render it unsatisfactory for its intended purpose, there is no legally proper suggestion or motivation to make that modification.

The final Office Action's rejection statement concedes that the Skarne reference does not disclose "fabric covering material covering at least a portion of the foam core

and defining an exterior surface of the cosmetic product, wherein the covering material comprises a material other than foam.” Final Office Action at 4. The final Office Action concludes, however, that it would have been obvious “to employ the covering material as taught by Spector into the cosmetic container of Skarne for the purpose of providing aesthetic look.” Id. Applicant respectfully disagrees with that conclusion because encasing the Skarne device in the fabric casing disclosed in the Spector reference would render it inoperable.

The Skarne reference discloses a cosmetic compact including a housing 20, a mirror 22, and an inner cosmetic compartment 24 that contains make-up powder. The exterior of the housing 20 “preferably” has a matte surface. The housing 20 includes two coextensive flaps 26 and 28 for holding the mirror 22 and the cosmetic compartment. The flaps 26 and 28 are hinged integrally at anchor region 30. In order to use the Skarne compact, the user must open the co-extensive flaps 26 and 28 via action of the integral hinge of the anchor region 30 to access compact contents.

As outlined above, the Spector reference discloses coating a perfume bottle 10 with a bonding agent so that the fabric of the fabric casing 11 is integrated with the perfume bottle 10 and so that the fabric effectively becomes the outer surface of the perfume bottle 10. Col. 3, lines 37-40. In other words, Spector discloses coating a perfume bottle with bonding agent and inserting the coated perfume bottle into a fabric casing in order to integrate the perfume bottle and the fabric of the casing. If, however, the Skarne compact were coated with a bonding agent and placed in a fabric casing, thereby integrating the compact with the fabric of the casing, there would be no way for the user to open the compact and access any of its contents, thus effectively defeating

the intended purpose of the Skarne compact. Therefore, since the final Office Action's proposed hypothetical modification to the Skarne reference would render it inoperable, there is no legally proper suggestion or motivation to make that modification.

Accordingly, independent claims 1, 4, and 16 are not *prima facie* obvious based on the Skarne and Spector references, and therefore, they should be allowable.

Claim 6 was rejected under 35 U.S.C. § 103(a) based on Skarne combined with Spector and Gueret (U.S. Patent No. 5,865,194). Since claim 6 depends from independent claim 4, it should be allowable for at least the same reasons claim 4 should be allowable.

Conclusions

For at least the reasons set forth above, independent claims 1, 4, and 16 should be allowable. Claims 2, 3, and 19-21, claims 5-15 and 22-25, and claims 17 and 18, depend from independent claims 1, 4, and 16, respectively. Consequently, those dependent claims should be allowable for at least the same reasons that claims 1, 4, and 16 are allowable.

Applicant therefore respectfully requests the reconsideration of this application, the withdrawal of the outstanding claim rejections, and the allowance of claims 1-25.

If the Examiner believes that a telephone conversation might advance prosecution, the Examiner is cordially invited to call Applicant's undersigned representative at 571-203-2739.

Applicant respectfully submits that the final Office Action contains numerous assertions concerning the related art and the claims. Regardless of whether those

assertions are addressed specifically herein, Applicant declines to automatically
subscribe to them.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: November 12, 2003

By: 

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